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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,309	10/27/2003	Peggy E. Hellberg	2395 US	3568
7590 07/07/2009				
Teresa J. Schultz Alcon Research, Ltd. 6201 South Freeway, Q-148 Fort Worth, TX 76134-2099			EXAMINER FAY, ZOHREH A	
			ART UNIT	PAPER NUMBER
			1612	
			MAIL DATE	DELIVERY MODE
			07/07/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/694,309

Applicant(s)

HELLBERG, PEGGY E.

Examiner

ZOHREH A. FAY

Art Unit

1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Claims 1, 3, 4 and 5 are presented for examination.

The response to the restriction requirement of March 19, 2009 has been received and entered.

Applicant elected open angle glaucoma for examination purpose.

Claims 1 and 3-5 are rejected under 35 U.S.C. 112 first paragraph for the reasons set forth on pages 2 and 3 of the office action of September 4, 2009, and the following reasons. The claims are also indefinite as to the term "despeptides". Such term fails to set forth the metes and bounds of the claimed invention. The instant specification fails to set forth compounds encompassed by such term.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xiao (US 7,250,514) in view of Clark (US 5,464,866).

Xiao teaches the use of histone deacetylase inhibitors (e.g. SAHA) for the treatment of conditions with abnormal angiogenesis and neovascularization including diabetic retinopathy and neovascular glaucoma. See the abstract, column 3, line 1, column 4, line 36, column 14, line 8, column 15, line 13, column 29, lines 49-65 and column 30, line 19. Xiao does not expressly teach the use of histone deacetylase for the treatment primary open angle glaucoma.

Clark et al. teach that affecting neovascularization can treat conditions including diabetic retinopathy, neovascular glaucoma and chronic glaucoma (Col. 7 line 34-63).

It would have been obvious to one skilled in the art at the time the claimed invention was made to use the histone deacetylase inhibitors for chronic glaucoma, as suggested by Clark et al., and produce the instant invention. It would have been obvious to one skill in the art as Xiao teaches the use of compounds having histone deacetylase activity for the treatment of abnormal angiogenesis and neovascularization such as diabetic retinopathy and neovascular glaucoma; Clark teaches that treatment of

neovascular conditions of the eye includes diabetic retinopathy, chronic glaucoma; and it would have been obvious to one skilled in the art to use histone deacetylase inhibitors which treat neovascular conditions and names diabetic retinopathy and neovascular glaucoma, to treat other related neovascular conditions of the eye, such as chronic glaucoma as addressed by the art.

One skilled in the art would have been motivated to do this because it is desirable to treat as many neovascular conditions as possible and it is desirable to be able to treat as many patient population as possible with the same compound.

Double Patenting

Claims 1 and 3-5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 and 3 of copending Application No. 10,531,747. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap. The claims of the instant application are drawn to the use of the specific histone deacetylase inhibitors for the treatment of acute or degenerative diseases of the eye, such as open angle glaucoma. The claims of the the copending application are drawn to the use of the same histone deacetylase inhibitors for the treatment of glaucoma and AMD. The claims of the copending application are within the scope of the claims of the instant application .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments regarding the 112 second paragraph, regarding the term "MS-275" have been carefully considered, but are not deemed to be persuasive. Applicant in his remarks argues that the term "MS-275" is not indefinite because a person skilled in the art at the time the application was filed recognizes that MS-275 was a HDAC inhibitor. It is the examiner's position that applicant is defining the compound by the function and the structure or chemical name. Therefore, in the absence of understanding of which compound is being used for treating glaucoma, the claim is considered to be indefinite.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ZOHREH A. FAY whose telephone number is (571)272-0573. The examiner can normally be reached on Monday to Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fredrick Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ZF
/Zohreh A Fay/
Primary Examiner, Art Unit 1612